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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1947

No. 163- 164

EDWARD J. MILLER, d/b/a
PERMA-STONE COMPANY,

Petitioner,

v.

EMIL P. ZAHARIAS, CHESTER POLANIS, d/b/a LINCOLN HOME BUILDERS, BERNHARD WALLACE, JACK CASTRONOVO, ALBERT SALOMON, JANET SALOMON and MAXON W. POLLAND,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF

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MILWAUKEE

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To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Edward J. Miller, doing business as Perma-Stone Company, respectfully prays for a Writ of Certiorari to the Circuit Court of Appeals for the Seventh Circuit to review an opinion of that Court filed May 7, 1948 affirming in part and reversing in part a decision of the District Court rendered February 13, 1947.

A certified copy of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with Rule 38 of the Rules of this Court.

SUMMARY STATEMENT OF THE MATTER INVOLVED

This suit was brought in the United States District Court for the Eastern District of Wisconsin by plaintiff Edward J. Miller, doing business as Perma-Stone Company, a resident of Columbus, Ohio. He sought to restrain the several defendants, all residents of Milwaukee, Wisconsin, from further infringement of Letters Patent No. 1,888,234 and 1,960,276, issued to and owned by the said Miller, and to recover damages for past infringement of said patents on the part of the defendants.

The District Court held that the claims in suit of Patent No. 1,888,234, namely claims 3, 4, 6 and 7 are invalid but that all of said claims except claim 6 are readable upon defendants' method. It also held that the claims in suit of Patent No. 1,960,276, namely claims 1, 2 and 5, are valid and infringed, but denied relief to the plaintiff thereon on the grounds that plaintiff was using the patents in suit to control the sale of unpatented materials. The question of such improper use of the patents in suit was one of the issues presented on appeal to the Circuit Court of Appeals for the Seventh Circuit, but that court held that all of the claims in suit, of both patents, are invalid, and its opinion therefore did not reach the question of unlawful extension of the patent monopoly. The questions presented by this Petition, therefore, have to do only with the validity of the two patents in suit, and the discussion will accordingly be confined to them.

The patents in suit relate to a method and tool for imparting to walls of buildings and the like a surface resembling stone. Patent No. 1, 888, 234 (R 266) contains claims to both the method and the tool, but inas-

much as only the method claims Nos. 3, 4, 6 and 7 are in suit, it will be referred to herein either as the "method patent" or as '234.

In practicing the patented method a shallow mold-like tool is used having an irregular bottom surface which forms an intaglio face resembling that of stone. In the case of the specific tool shown in '234 the surface is surrounded by a movable husk, but this is not required in the practice of the patented method. One mold section of the corner tool disclosed in Patent No. 1,960,276 has no husk, and the straight molds used by defendant Castronovo in the infringing practice of the method had rubber flanges at their edges. Castronovo later removed these (R 51) and continued to practice the method successfully. In short, it is only necessary that the tool have a surface "formed to resemble the finish desired" (Claim 4, R 268), and the remaining details of the tool are entirely optional with the user.

In practicing the patented method a flexible membrane is first placed over this surface of the tool and the membrane, in turn, is covered with plastic cement. In order to impart a natural stone-like color to the finished product powdered coloring material is ordinarily sprinkled over the membrane before the plastic cement is put over it, but the use of color is obviously not essential to the method and is not referred to in the claims.

With the aid of the tool the workman places the plastic cement in contact with the wall surface and at the same time applies pressure to the tool so that the cement will adhere to the wall and take the stone-like impression of the intaglio surface. (Plaintiff's Exhibits 5 and 6; R 50-54). He then withdraws the tool, leaving the waxed paper in place on the cement, which adheres to the wall

in a configuration bearing a close resemblance to the face of a stone.

> "The waxed paper or other suitable flexible material which covers the face of the plunger [tool] to prevent the adhesion of the material to the plunger is left on the surface of the pressed material to cover the completed wall. This causes the material to cure from the inside and permits a more thorough dehydration of the same, thus producing a harder and more durable surface. The coating of waxed paper also serves to hold the plastic material against sagging from its own weight." (R. 268, lines 34-45)

In addition, the flexible membrane serves the obvious purpose of protecting the surface of the freshly formed stone from drippings as stones are cast above it.

The claims in suit of '234 cover the method of creating an artificial stone surface in this manner. The District Court found that these claims, while readable upon defendants' method (except for claim 6) are invalid "because they described the functions of the tool or device, and because they are not defined with sufficient particularity to inform the public so as to enable it to avoid infringement." (R 240) The Circuit Court of Appeals for the Seventh Circuit held that:

> "All that plaintiff did in the claims in suit was to inform the public how to use his patented device. He described the tool fully and then told how to operate it, but his only claim of invention with which we are concerned is his direction as to how to use the old device. This, we think the District Court correctly held, could not amount to patentable novelty." (Opinion, p. 2)

It is to be noted that the tool is nowhere suggested in the prior art, and there is no finding, by either of the courts below, that the tool is not novel with the plaintiff.

In fact, the method patent also contains claims to a specific tool for practicing the patented method (the tool illustrated in the drawings of the patent) but these claims are not in suit since they do not read upon the tool used by defendants in their practice of the method.

While the method patent discloses means for simulating stone facing on a two-dimensional surface, it does not take care of the corner of a wall and form a facing having the appearance and depth of a three-dimensional stone with two of its surfaces exposed. The tool for accomplishing this is disclosed in Patent No. 1,960,276 (R 272; hereinafter known as '276) issued to and owned by plaintiff Edward J. Miller. The application for '276 was filed August 22, 1932 and it issued May 29, 1934, so that it was copending with the method patent which issued November 22, 1932.

The tool with which plaintiff simulates corner stones consists essentially of two surface molds hinged together to enable one of them to be freely swung around the corner of a building after both molds have been filled with cement. In filling the molds they are held in coplanar end-to-end relationship so that both may be filled at the same time, and they are applied around the corner in one operation. (Plaintiff's Exhibit 6, reproduced opposite p. 18 infra.) The District Court held that the claims in suit of '276 are valid and infringed. (R 241-242) The Circuit Court of Appeals, however, found the corner mold patent invalid, stating:

> "We think this does not constitute invention. The single tool itself was covered by the first patent, and we are unable to conceive of any ground upon which we can say that when Miller hinged together two of the patented tools so as to deposit material to both sides of a corner of a building, instead of plac-

ing it on a flat surface in a straight line, he achieved invention." (Opinion, p. 4)

The Appellate Court's opinion makes no reference to the fact that the two patents in question were copending. Nor did the District Court refer to copendency; instead it specifically held that the corner mold was inventive. (R 241)

JURISDICTION

The suit arises under the patent laws of the United States, Title 35 U.S.C. §§ 67, 70.

The jurisdiction of this Court is invoked under Title 28 U.S.C. § 347 (a) (Sec. 240 (a) Judicial Code).

The opinion of the District Court (R 235) is reported at 72 F. Supp. 29.

The opinion of the Circuit Court of Appeals is reported at 167 F. (2d) —, 77 U.S.P.Q. 335.

QUESTIONS PRESENTED

The following questions are presented for the consideration of this Court:

1. Did the courts below err in holding that the claims in suit of the method patent No. 1,888,234 are invalid because they merely recite the function of a tool?

2. In holding invalid the claims in suit of patent No. 1,960,276 (the corner mold patent) did the Circuit Court err in failing to apply the rule that one of two copending patents to the same patentee cannot be used to anticipate the other?

REASONS FOR GRANTING THE WRIT

Your petitioner respectfully prays that the writ be allowed for the following reasons:

1. The decision of the Circuit Court of Appeals for the Seventh Circuit is out of harmony with the decisions of this Court and of the circuit courts of appeals of other circuits on the question of functionality of method claims, and particularly with *Smith v. Snow,* 294 U.S. 1, 55 S. Ct. 279 and *Naivette v. Bishinger,* 61 F. (2d) 433 (C. C.A.-6, 1932). The decision is also out of harmony with other decisions of the Circuit Court of Appeals for the Seventh Circuit, namely *Smith Engineering Works v. Nordberg Manufacturing Co.,* 68 F. (2d) 492, and *Interstate Folding Box Co. v. Empire Box Corporation,* 68 F. (2d) 500.

2. The decision of the Circuit Court of Appeals is out of harmony with the oft-stated rule that copending patents cannot anticipate one another. *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.,* 22 F. (2d) 259 (C.C.A.-2, 1927); *B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co.,* 122 F. (2d) 900 (C.C.A.-1, 1941). The decision is also out of harmony in this respect with the Seventh Circuit case of *Shipp v. Scott School Tp., Mongomery, Co. Indiana,* 54 F. (2d) 1019 (1931).

3. The decision of the Circuit Court of Appeals for the Seventh Circuit is so obviously incorrect, particularly on the question of the validity of patent No. 1,960,276 (the corner mold patent), as to call for the exercise of this Court's supervision to insure that justice shall be done.

Wherefore your petitioner respectfully prays that a Writ of Certiorari be issued under the seal of this Court,

directed to the United States Circuit Court of Appeals for the Seventh Circuit, commanding the said court to certify and send to this Court, on a day to be designated, a full and complete transcript of the record and all proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court, as provided in the Statutes of the United States, that the judgment of the Circuit Court of Appeals be reversed, and that petitioner be granted such other and further relief as may seem proper.

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July 9, 1948.

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

STATEMENT

The facts so far as this application is concerned are sufficiently stated in the Petition.

SPECIFICATION OF ERRORS

For the errors which petitioner will urge if the Writ of Certiorari is granted the Court is respectfully referred to that part of the Petition which sets forth the questions presented (p. 6) and to that part which states the reasons why the Writ should be granted (p. 7).

SUMMARY OF ARGUMENT

(1) In arriving at its decision that the claims in suit of patent No. 1,888,234 (the method patent) are invalid the Circuit Court overlooked the fact that an indispensable step, recited in each of said claims, is the placement of a flexible membrane upon the surface of the tool, and the court in its opinion did not so much as mention this membrane or its function in connection with the invention and in its relation to said claims.

(2) In holding the claims in suit of the method patent invalid the Circuit Court failed to distinguish between a method which requires the use of a machine or tool in one of the steps of its performance and a situation in which the result achieved is merely the inherent function of a machine or tool. This error flows from the court's failure to apply the correct test in determining the validity of method claims.

(3) In holding the claims in suit of Patent No. 1,960,276 (the corner mold patent) invalid, the Circuit Court overlooked the rule which states that where more than one application for patent by the same person is *copending,* one of the applications, or the patent granted thereon, cannot be used to anticipate the other.

1. The Use of the Flexible Membrane.

The Circuit Court's opinion on the method patent (No. 1,888,234) is premised upon the assumption that petitioner's real invention is the tool, and that, given the tool, plaintiff's method of applying simulated stone is inherent therein. In order to facilitate the Court's understanding of the method, a chart, Plaintiff's Exhibit 5 is reproduced herewith, illustrating claim 4.

The issue of functionality in this case is by no means an easy one to analyze, but it may perhaps be best presented by means of two analogies:

1. Given a typewriter as something that had never before been made, it would be apparent to any literate person skilled in the mechanical arts that the machine is capable of printing a manuscript letter by letter by the operation of pressing selected keys. The function of the machine would be inherent in it, and a claim to that function would be entirely improper.

The Circuit Court's opinion assumes that petitioner's mold is analogous to the tyepwriter, and that, given the mold, a man skilled in the art of masonry would recognize that petitioner's tool, like the typewriter, can be used in only one way. In other words, the court holds that every step in the surfacing of a wall is accomplished by the tool itself, in the same sense that every step in the typing of a letter is accomplished by the typewriter. Basically, therefore, the court holds that the tool is the invention.

2. Given a screwdriver and a table full of parts, a man is told to assemble a typewriter from the parts. The screwdriver is obviously essential to the assembly job, and let it be assumed that it is the only tool required. Now, can the man, by looking at the screwdriver and apprising himself of its function, learn how to perform the numerous steps necessary to assemble the machine? He can readily see that the screwdriver is valuable for inserting screws into threaded holes. He can appreciate its function with relation to any individual act of assembly involving screws. But he obviously still knows nothing about the successive steps which he must perform by means of the screwdriver in assembling the machine. In other words, he must still be taught a method. This

represents petitioner's position, in which the tool is analogous to the screwdriver.

The question, therefore, is whether the invention is limited to the tool itself (the "typewriter") or embraces both a tool and a method ("screwdriver" plus "assembly instructions").

It is respectfully submitted that the Circuit Court, in concluding that the invention is no broader than the tool, has overlooked, inter alia, the use of waxed paper in the performance of petitioner's method.

Each of the method claims in suit recites as one of the steps in the patented method the placement of a thin membrane upon the surface of the tool. This membrane is obviously not an inherent part of the tool itself, and yet its use is absolutely indispensible to the performance of the method described in the patent.

The waxed paper membrane fulfills a number of important functions (p. 4, supra):

> It prevents the cementitious material from adhering to the surface of the tool.
>
> It causes the material to cure slowly, from the inside, thus producing a harder and more durable surface.
>
> It serves to hold the plastic material against sagging from its own weight.
>
> It protects the surface of the freshly formed "stone" from drippings as stones are cast above it.

The waxed paper membrane is thus at the heart of petitioner's invention and its use is essential to the success of petitioner's method. Although not referred to in terms as such, the waxed paper is also a "tool" used in the performance of the method, and it is as indispensable

to the method as the tool having a surface "formed to resemble the finish desired." Yet the waxed paper could obviously not be claimed as an element of the tool claims, nor could it be claimed as an invention per se. This, in itself, would seem to indicate that the invention is broader than the tool alone, and that it resides in a method in which the tool merely plays a part.

Following the line of the Circuit Court's reasoning let us present to a hypothetical skilled mason, unfamiliar with petitioner's method or patent, a bucket of cement, a wall upon which a simulated stone surface is to be applied, and the tool disclosed in the method patent. If, as the opinion states, the "prescribed operations of the purported method are obviously inherent in the elements of the patented device as the peculiar and characteristic functions thereof," then the hypothetical mason, by an analysis of the tool, could determine how petitioner's method is to be practiced.

But it is submitted that he would not find the method inherent in the tool, any more than the method of assembling a typewriter is inherent in the screwdriver used in its assembly. By analyzing the tool the mason might, for example, decide that the proper way to use it would be to put a coating of plastic cement on the wall and then, by the application of the tool thereto, impress the desired configurations into this coating. Or he might conceivably place the cement directly upon the mold surface and thereafter press it against the wall, and he would then obtain an extremely rough and completely unsatisfactory finish. Or he might do what petitioner himself did in the early stages of his experimental work and coat the mold surface with oil, grease or wax. This would be equally unsuccessful.

It follows that the method is not in fact inherent in the function of the tool, and that even though the claims in suit, as the Circuit Court states, "amount merely to directions as to how to use a patented device," (Opinion p. 2) they are something more than a statement of the *function* of that device, just as the directions for assembling a typewriter would be something more than a statement of the function of a screwdriver.

It is submitted, therefore, that the Circuit Court has arrived at its holding of functionality by overlooking completely the role of the waxed paper membrane in the petitioner's method. This presumption is strengthened by the fact that the opinion nowhere refers to the use of waxed paper even though it plays an indispensable part in the method and its use is in itself a distinct inventive concept.

It should be noted, incidentally, that while the tool is referred to on page 2 of the Opinion as "the old device," no suggestion of any such tool is to be found in the prior art, the District Court did not make any finding to the effect that the tool is not broadly new with the petitioner, and the opinion of the Circuit Court makes no reference to the novelty of the tool per se.

2. The Question of Functionality.

In the preceding section the Circuit Court's holding is analyzed from the standpoint which the court apparently took. The reasoning of the opinion in effect begins with a consideration of the tool and then proceeds from it to the question of the functionality of the method claims. It has been shown that even by this process of analysis there is no justification for holding the method claims invalid.

However, this is not the test which the authorities sanction. The proper approach is to begin with the method claim itself and to determine from an analysis of it whether it is a statement of that which is inherent in the function of a patented tool or machine. This analytical process is the reverse of that followed in the preceding section.

Where a particular machine, by itself, performs all of the successive steps of a method, then a claim to the function of that machine would obviously be invalid. This is the gist of the two paragraphs quoted from the *Interstate Folding Box Company* case on page 3 of the Opinion. But:

> "A new process may be invented or discovered which may require the use of newly invented machinery. In such a case, if both the process and machine are invented by the same person, he may obtain separate patents on the machine and the process."
>
> *Smith Engineering Works v. Nordberg Mfg. Co.*, 68 F. (2d) 492 @494 (C.C.A.-7, 1934)

Thus the mere fact that a patentee gives directions which tell how to use a device (old or new) in the performance of a new method does not of itself make for a functional claim.

> "It is the lack of novelty in the steps or in their combined use that defeats validity rather than the use of a machine to perform an act which constitutes a step in the process claim. The act which is one of the successive steps of a valid process claim may be performed by a machine as well as by hand."
>
> *Interstate Folding Box Co. v. Empire Box Corporation,* 68 F. (2d) 500 @ 501 (C.C.A.-7, 1934)

Thus, when the process of analysis begins with the method claim itself, it sometimes happens that a method claim is found to be valid, even though its practice involves the use of well known mechanism. The Circuit Court of Appeals for the Seventh Circuit decided just such a case in *Lakeshire Cheese Co. v. Shefford Cheese Co.*, 72 F. (2d) 497 (1934). In analyzing the method claims the opinion pointed out that (p. 498):

> "By reading these claims, in the light of the specifications, it is apparent that the process involved consists of: (a) The passing of a stream of cheese continuously through steam; or sending it through a cylindrical tube by means of a screw conveyor where it is kneaded and exposed momentarily to jets of steam, (b) having a temperature sufficient to reduce particles of cheese substantially to a liquid upon momentary exposure thereto, (c) exposing substantially all particles of said cheese momentarily to such steam, and, (d) then immediately removing them out of contact therewith."

It will be seen that the process here involved was intimately tied up with the machinery necessary to perform it, and that the machinery itself was old. Yet, as the court pointed out (p. 499):

> "The machinery pointed out as suitable to perform the process may or may not be new or patentable; whilst the process itself may be altogether new, and produce an entirely new result."

Again, in *Naivette v. Bishinger,* 61 F. (2d) 433, the Circuit Court of Appeals for the Sixth Circuit held that method claims to a process of hair waving were valid, while claims in the same patent to a certain apparatus used in practicing the method were invalid as being old in the art. The court commented (p. 436):

> "There is no contradiction in sustaining validity of a process, which includes clamping as a step in a new combination, and yet to deny validity to the patent for a clamp as a unitary device."

An important test, which is almost invariably applied to method claims in the reported decisions, has been expressed by Judge Evans in the following language[1]:

> "If all of the acts are merely the results following the operation of a machine and *are necessarily restricted to the specific machine* covered by a patent, the validity of such process claims can not be upheld." (Emphasis supplied)

The question, in other words, is whether the process can be performed *only* by the *specific machine*. If so, then the claim is invalid.[2] The corollary of this rule has frequently been stated by the Court of Customs and Patent Appeals.

> "We think it is well settled that the inventor of an apparatus may be allowed method claims if the method performed by the apparatus may be performed by other apparatus or by hand. The mere fact that he has invented a machine for carrying out his process does not make him any the less an inventor of the process, provided the machine and process both are new and useful and otherwise meet the requirements of the statute. * * * "

[1] *Smith Engineering Works v. Nordberg Mfg. Co.,* 68 F. (2d) 492 @ 494.

[2] An example of the application of this test to invalidate a method claim is found in *Chisholm-Ryder Co. v. Buck,* 65 F. (2d) 735 @ 736 (C.C.A.-4, 1933).

> "* * * Thus it appears that the method proposed may be performed by the patented machine; but the evidence fails to indicate how the process may be carried out practicably in any independent fashion, and the result is that the process patent merely states the function or effect of the machine, and is invalid under the established rule."

In re McCurdy, 76 F. (2d) 400 @ 402.

"In other words, if the machine performs a new, useful, inventive method, the party is entitled to method claims along with his machine claims not only because his method requires protection but because they are related inventions. The method of the operation of the machine may, in some instances, be inventive when considered independently of the machine, or may be a related invention to that of the machine and allowable only as claims for a dependent invention in the same application as that of the machine. The claims for a method which depend upon a machine and which are allowable only along with article claims in one application should never be measured, when their allowability is being considered, by the standard which would be required if they were in a separate application and for a separate and unrelated invention."[1]

Application of Barnett, 155 F. (2d) 540 @ 544 (C.C.P.A., 1946)

See also:

Waxham v. Smith, 294 U.S. 20, 55 S.Ct. 277 (1934).

Applying this test, now, to the method claims of the instant case it will at once be seen that those claims recite the steps of an art or process as that term is understood in the patent law. The method of the claims in suit can very definitely be practiced with a variety of tools other than the one specifically described in the method patent. It may be practiced with a tool like that shown and claimed in the patent to Fralick, No. 2,286,531 (R 338), which is, ostensibly at least, patentably different from

[1]The last sentence apparently goes farther than most holdings, but it is nonetheless worthy of note as a recent pronouncement by a court well qualified by its specialization to speak on the law of patents.

petitioner's particular tool. It may also be practiced with a tool like that used by Castronovo, which does not come within the purview of the tool claims of petitioner's patent or the Fralick patent. And, it might be noted, it is also practiced with the corner mold tool of petitioner's Patent No. 1,960,276. The only common characteristic of these tools is that each has a surface "formed to resemble the finish desired."

How, then, can it be said that the method claimed by petitioner is a function of *the* tool described by him, or of *any particular* tool, when that method may be practiced with any of four different (even *patentably* different) tools?

This fact that the method may be performed with a variety of tools is a clear indication that the petitioner's invention is broader than the tool and its function. The real invention, it is submitted, is the method, as defined by the claims in suit.

3. Copending Patents Can Not Anticipate One Another.

It is submitted that in arriving at the conclusion that the claims in suit of the corner mold patent are invalid the Circuit Court has held that the disclosure of the tool in the method patent was an anticipation of the tool of the corner mold patent. This is apparent from the following sentence of the opinion, which appears on page 4 thereof:

> "The single tool itself was covered by the first patent, and we are unable to conceive of any ground upon which we can say that when Miller hinged together two of the patented tools so as to dispose material to both sides of a corner of a building, instead of placing it on a flat surface in a straight line, he achieved invention."

Petitioner submits that this holding was erroneous in view of the well recognized rule that where more than one application for patent by the same person is copending[1], one of the applications, or the patent granted thereon, can not be used to anticipate the other. In other words, it is not necessary to the validity of the corner mold patent that it should have achieved invention over the tool of the first issued patent.

The rule is succinctly stated in *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 22 F. (2d) 259 @ 260 (C.C.A.-2, 1927) in which Judge Learned Hand, speaking for the court said:

> "Calkins' earlier patent was not part of the prior art, and *it is not necessary to the validity of the claims in suit that they should embody a patentable advance over the earlier disclosure.* The two applications were copending, and it is a matter of indifference which of the patents issued first, provided that the claims are for separate inventions. This was held after elaborate discussion in Miller v. Eagle Mfg. Co., 151 U.S. 186, 14 S. Ct. 310, 38 L. Ed. 121, and had been already decided in Suffolk Co. v. Hayden, 3 Wall. 315, 18 L. Ed. 76. It has often been decided in this court (Electrical Accumulator Co. v. Brush Electric Co., 52 F. 130; Thomson, etc., Co. v. Elmira, etc., Co., 71 F. 396; Kinnear Mfg. Co. v. Wilson, 142 F. 970; Victor, etc., Co. v. American, etc., Co., 145 F. 350), and is the law elsewhere (Thomson, etc., Co. v. Ohio Brass Co., 80 F. 712 (C.C.A.-6); Century, etc., Co. v. Westinghouse, etc., Co., 191 F. 350 (C.C.A.-8)." (Emphasis supplied)

For a more recent statement of the rule see *B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co.*, 122

[1]Application for the method patent (No. 1,888,234) was filed Nov. 9, 1929 and the patent issued Nov. 22, 1932 (R 267). Application for the corner mold patent (No. 1,960,276) was filed Aug. 22, 1932 and the patent issued May 29, 1934.

F. (2d) 900 @ 913 (C.C.A.-1, 1941, cert. den. 62 S. Ct. 917, 315 U.S. 823, 86 L. Ed. 219).

The application of this rule may be somewhat clearer from a consideration of its corollaries. Assume that petitioner had disclosed the corner mold patent, and drawn claims thereto, in the original application for the method patent. It is common Patent Office practice to require division where separate inventions are presented in a single application, and it is entirely possible that division would have been required in the instant case had the application been so filed. In that event the divisional application would have been filed later and prosecuted separately, and the parent application, or the patent issued thereon, would certainly not then be cited against the divisional application as anticipatory art.

Another corollary situation is that illustrated by the following from the Seventh Circuit case of *Shipp v. Scott School Tp., Montgomery County, Ind.*, 54 F. (2d) 1019 (1931), opinion per Judge Evans):

> "It is not necessary to refer more particularly to the disclosures of these two patents because of our conclusions that they were not a part of the prior art. The question involving their consideration may be stated thus: May A, who seeks a patent upon a certain structure and discloses, but does not cover by claim, certain novel features therein, apply, within two years from the reduction of his invention to practice, for a new patent covering the disclosed but unclaimed novel features in the earlier application, when it appears that the second application was made *after the patent on the first application had issued?*" [@ 1021, emphasis supplied]
>
> "It follows, therefore, that Shipp was not prevented from prosecuting his application for the patent in suit because of the issuance to him of the

other two patents, and, as a corollary, that the said two patents, under the facts here disclosed, did not constitute a part of the prior art as against him." [@ 1022]

This situation must not be confused with that involved in cases of double patenting, where the two patents in question *claim* the same thing.

> "Therefore all we have to do in the case at bar is to decide whether the claims in suit are for a separate invention from the original claims allowed upon the first application. Clearly the test of this question is not whether the step between the later claims and the earlier required invention."
>
> *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 22 F. (2d) 259 @ 261 (C.C.A.-2, 1927)

> "* * * It is immaterial, that the earlier and later of two copending patents, make identically the same disclosure, if the same elements are not found in the combination set forth in the two claims under comparison."
>
> *Montgomery Ward & Co. v. Gibbs*, 27 F. (2d) 466 @ 469 (C.C.A.-4, 1928)[1]

In the instant case the claims of the corner mold patent are clearly directed to a separate invention, and different elements are found in the claims of the corner mold patent, since each of those claims recites hinge means. The respondents not only concede this point absolutely, but indicated in their brief in the Circuit Court of Appeals that the corner mold is in itself inventive:

> "Standing alone, it could and perhaps would amount to invention." (Defendant's Brief, p. 33)

[1] Cert. den. 278 U.S. 630, 73 L. Ed. 548, 49 S. Ct. 29.

This, therefore is all that is required for the validity of the corner mold patent.

CONCLUSION

This is such a case as merits the consideration of this Court. It is respectfully urged that a Writ of Certiorari issue herein.

Respectfully submitted,

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July 9, 1948.

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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1948

Nos. 163-164

EDWARD J. MILLER, d/b/a
PERMA-STONE COMPANY,

Petitioner,

v.

EMIL P. ZAHARIAS, CHESTER POLANIS, d/b/a LINCOLN HOME BUILDERS, BERNHARD WALLACE, JACK CASTRONOVO, ALBERT SALOMON, JANET SALOMON and MAXON W. POLLAND,

Respondents.

REBUTTAL BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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REBUTTAL BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

---

1. Concerning Respondents' Argument that the Questions Presented by the Petitioner are Now Moot.

Respondents argue that this Court could not decide the question of the petitioner's estoppel to enforce his patents in suit in view of his alleged misuse of them, since that question has not been presented by the petition. On this basis respondents contend that this petition presents a moot question since if this Court holds the claims in suit valid, those claims would still be unenforceable.

One answer to this point is exceedingly obvious. The question of estoppel *could not* be presented to this Court because it was not passed upon by the Circuit Court of Appeals. Contrary to respondents' statement that "That question was decided adversely to petitioner by affirmance of that part of the judgment . . . " (Brief, p. 4), the Circuit Court of Appeals expressly refused either to affirm or reverse the District Court on this point, saying (R 344): "We do not reach the other points presented to the District Court."

Respondents are in error in their contention that "Should petitioner prevail upon either or both of his questions herein presented, there still could be no reversal." (p. 4) If petitioner prevailed in this Court the case would be remanded to the Circuit Court of Appeals, and that court would then have to rule upon the question of the enforceability of the patents in suit.

It is also appropriate to point out in this connection that even if the Circuit Court held the patents in suit to be unenforceable as to past infringements thereof, misuse of those patents would not bar the patentee from future enforcement of his rights upon a showing that he had purged himself of his wrongful conduct.

> "Improper use does not invalidate a patent, but the courts will not assist an offending patent owner against persons who infringe the patent while such improper practices continue. Improper use does not vest an infringer with a license for the life of the patent, for if a patent owner purges himself of the improper business practices he may then enforce his patent and recover damages for infringement occurring thereafter."
>
> *Novadel-Agene Corp. v. Penn,* 119 F. (2d) 764 @ 766 (C.C.A.-5, 1941)

See also:

Sylvania Industrial Corp. v. Visking Corp., 132 F. (2d) 947 (C.C.A.-4, 1943)

2. Concerning Respondents' Argument that There is No Conflict of Decisions Between Different Circuit Courts of Appeals.

In their arguments on this point respondents state (p. 4) that "There is no allegation in the petition for a writ that the decision of the Circuit Court of Appeals for the Seventh Circuit is in conflict with a decision or decisions of Circuit Courts of Appeals on the same subject matter or adjudicating the validity of the same patents." It is significant, as indicating the obvious weakness of respondents' contention, that they do not in any wise discuss, or even mention, the numerous cases cited at p. 7 of petitioner's brief to illustrate the complete disharmony between the decision in the instant case and decisions of the Circuit Court of Appeals for the Seventh Circuit in other cases, as well as the decisions of this Court and the courts of appeals of other circuits.

Instead respondents seek to bolster their contention with an argument to the effect that this Court will not consider "questions of anticipation and invention." But such questions are not presented by this petition. The petitioner seeks to have this Court review two questions of law, namely: (1) are the claims of the method patent in suit functional as a matter of law; and (2) can copending patents be used to anticipate one another.

These are not questions of fact. They have nothing to do with the questions of anticipation and invention. They are obviously questions of law.

3. Concerning Respondents' Argument that this Petition Presents No Question of General Interest.

Respondents again assert (p. 5) that the question which this Court is asked to resolve "is primarily one of fact." But as pointed out in the preceding section, this Court is not asked to decide "questions of anticipation and invention." It is asked to

decide questions of the interpretation of law, concerning which there is now a serious conflict of opinion.

More important, perhaps, is the fact that the decision of the Circuit Court of Appeals, particularly on the question of the copending corner mold patent, is so obviously incorrect as to warrant the exercise of this Court's supervisory power. It is always of "general interest" to insure that a litigant shall have substantial justice.

Finally, some idea of the importance of this case may be obtained from the following facts:

The petitioner has licensees under his patents in suit in all of the forty-eight states of the Union except Vermont.

In 1947 approximately eighteen million dollars ($18,000,000.00) worth of siding work was done under the patents in suit.

The patents in suit have to do with an important aspect of the building industry, and find their most important application in the field of residential construction.

4. Concerning Respondents' Argument that the Use of the Flexible Membrane was Old in the Art.

In this section respondents discuss a point which is nowhere touched upon in the opinion of the Circuit Court of Appeals. It is, in fact, noteworthy that the opinion of the Circuit Court does not so much as refer to the use of a flexible membrane in the performance of the Miller method.

The fact that the court below failed to mention the membrane in its opinion suggests its failure to appreciate the significance thereof. Without a proper appreciation of the function of the membrane in the method, as defined by the claims, the claims could not be understood or passed upon. The only manner in which the respondents seek to justify the Circuit Court's failure

to mention the membrane is by contending that the flexible membrane per se is old in the art.

Respondents' argument on this point, moreover, is based upon an obviously erroneous interpretation of the two cases cited at p. 6 of their brief, *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 61 S. Ct. 235 and *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 47 S. Ct. 136.

Both of these cases are quite clear to the effect that proceedings in the Patent Office may affect the *construction* of claims in a patent as issued; but they do not say that such proceedings can have any effect upon the *validity* of those claims. As clearly pointed out in the following language in the I.T.S. case (272 U.S. @ 444), Patent Office proceedings are material only in determining the question of infringement (i.e., whether the claims are to be construed as readable upon the defendant's construction or method):

> "It results that the claims in suit were limited by the proceedings in the Patent Office to the specific form of a three-point contact lift, they are not infringed by the heels made by the Essex Company***."

However, respondents' entire argument on this point is irrelevant. There is no issue, one way or the other, as to the novelty of using a membrane. The question of the novelty of the *method,* which includes the use of a membrane as one of its steps, was presented to the Circuit Court of Appeals, but this is another of the issues upon which that court did not touch. The question for this Court has nothing to do with the novelty of the membrane *per se;* this Court is asked by the petition to decide whether a method claim which recites, *inter alia,* the use of a flexible membrane in a certain manner is void as stating the function of a tool.

5. Concerning Respondents' Argument that the Method Claims are Functional and Invalid.

In this section respondents merely reargue the question which this Court is asked to decide. The defects in their argument are set forth at length on pages 13 to 18 of petitioner's main brief and need not be repeated at this point.

The citation of petitioner's testimony concerning the claims of the method patent in suit is obviously irrelevant, since the issue of validity is not determined by what the patentee thinks about his patent or his invention, but by what the claims say. It will be noted, incidentally, that the testimony quoted by respondents in no wise supports their contention.

6. Concerning Respondents' Argument that the Corner Mold Patent Does Not Constitute Invention.

The gist of this argument resides in respondents' quotation of a sentence from the Traitel Marble Company case (cited at p. 19 of petitioner's brief) entirely out of its context. Respondents insist (p. 8) that the claims of two copending applications must be for "separate inventions," but the Traitel Marble Company case, as quoted at p. 19 of petitioner's brief, distinctly states that "it is not necessary to the validity of the claims in suit that they should embody a patentable advance over the earlier disclosure." Thus, although the claims are required to set forth different inventions, it is not necessary that they be *patentably* different. Yet it is the test of *patentable* difference which the Circuit Court of Appeals has applied in this case, and which respondents insist upon in their brief.

Respondents' argument falls into the error noted on page 21 of petitioner's main brief, i.e., it confuses the situation in this case with that involved in cases of double patenting where the two patents in question *claim* the same thing. This distinction has been set forth at length at p. 21 of petitioner's brief and will not be repeated at this point.

However, the fact that the Circuit Court of Appeals has fallen into this error, plus the fact that respondents have repeated it, affords a clear cut demonstration of the need for this Court to speak definitively upon the point.

7. Concerning Respondents' Argument that the Decision of the Circuit Court of Appeals was Correct.

This section of respondents' brief is little more than a summary of the preceding portions thereof, and it is therefore adequately answered in the foregoing paragraphs.

CONCLUSION

It is respectfully submitted that the dictates of justice, the importance of this case to the building industry as evidenced by the amount of business done under petitioner's patents, and the conflict of decisions on the questions presented hereby, warrant the issuance of a writ of certiorari.

Respectfully submitted,

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August 5, 1948

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IN THE

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OCTOBER TERM, 1948.

Nos. 163-164.

EDWARD J. MILLER, d/b/a PERMA-STONE COMPANY,
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v.

EMIL P. ZAHARIAS, CHESTER POLANIS, d/b/a LINCOLN HOME BUILDERS, BERNHARD WALLACE, JACK CASTRONOVO, ALBERT SALOMON, JANET SALOMON and MAXON W. POLLAND,
Respondents.

BRIEF FOR RESPONDENTS,

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OPPOSING APPLICATION FOR WRIT OF CERTIORARI.

OPINION BELOW.

The opinion of the Circuit Court of Appeals (R. 341) is reported at 168 F. (2d) 1, and the opinion of the District Court (R. 235) is reported in 72 F. Supp. 29.

JURISDICTION.

The judgment of the Circuit Court of Appeals was entered May 7, 1948 (R. 346), and a petition for rehearing was filed on May 20, 1948 (R. 346), denied on June 15, 1948 (R. 347). The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925 [28 U. S. C. A., Par. 347 (a)].

Petitioner has not advanced any valid reason for granting the writ. The District Court in its opinion (R. 235), held the challenged claims 3, 4, 6, and 7 of U. S. Letters Patent No. 1,888,234, invalid and claims 1, 2, and 5 of Patent No. 1,960,276 valid and infringed, but that petitioner was barred from maintaining his action because of unclean hands.

The Court of Appeals for the Seventh Circuit affirmed the District Court in its opinion (R. 341) as to the holding of invalidity of Patent No. 1,888,234, reversed the District Court and found that the claims of Patent No. 1,960,276 did not constitute invention and were invalid, and acquiesced in the judgment dismissing the complaint for unclean hands by not passing upon that point.

The opinion of the Circuit Court of Appeals thus left the judgment of the District Court dismissing the complaint for want of equity, undisturbed. Under the caption "Questions Presented", the petition for certiorari submits two questions. One deals with the holding of functionality as to the claims of the method patent No. 1,888,234, and the other deals with the rule that one of two copending applications to the same inventor cannot be used to anticipate the other, in reference to patent No. 1,960,276.

SUMMARY OF ARGUMENT.

The Index above under "Argument" contains 7 subdivisions which are in effect a summary of the argument hereinafter appearing. For that reason, no further "summary of argument" is given.

1. The Questions Presented by Petitioner Are Now Moot.

Petitioner for a writ has presented two questions in his petition for a writ. One deals with the holding of functionality of the claims of the earlier patent, and the other deals in respect of the later patent, with the rule which obtains between copending applications of the same inventor. (Page 6 of the petition.) Petitioner has not presented any question upon the principal and most important reason for dismissal of his complaint in the trial court, i. e., the application of the unclean hands doctrine to his conduct. The court of appeals did not disturb the ruling in this respect but also ruled invalid all claims of the corner mold patent. Consideration of the case in this court would necessarily be limited to the questions specifically brought forward by the petition as was so clearly pointed out in General Talking Pictures Corporation v. Western Electric Company, Inc., et al., 304 U. S. 175, 546 at 177 and 179, 58 S. Ct. 849 at 851, wherein this appears:

> (177) "Our consideration of the case will be limited to the questions specifically brought forward by the petition . . . (179) One having obtained a writ of certiorari to review specified questions is not entitled here to obtain decision on any other issue. (Citing cases) . . . Petitioner is not here entitled to decision on any question other than those formally presented by its petition for the writ." (Interpolations supplied.)

To the same effect, see Dickinson Industrial Site, Inc., v. Cowan et al., 309 U. S. 382, 60 S. Ct. 595, 84 L. Ed. 819,

and Washington, Virginia & Maryland Coach Co. v. National Labor Relations Board, 301 U. S. 142, 57 S. Ct. 648.

Petitioner raised on appeal, the question of the trial court's finding that he was using his patents in suit as the effective means of restraining competition in the sale of unpatented coloring matter in paragraph numbered "4" of his Statement of Points Relied Upon on Appeal (R. 250). That question was decided adversely to petitioner by affirmance of that part of the judgment by the Circuit Court of Appeals and has not again been presented here.

Should petitioner prevail upon either or both of his questions herein presented, there still could be no reversal of the judgment inasmuch as the principal reason for dismissal of the complaint, i. e., the finding that plaintiff's conduct estopped him from any relief in this action, could not be reached in this court. The questions now presented being moot, and assuming (but not conceding) that they were resolved for petitioner, that could still have no practical effect upon the case. See Wisconsin E. R. Board v. Allis Chalmers W. Union, 252 Wisconsin 436, at 441, 32 N. W. (2d) 190.

2. **There Is No Conflict of Decisions Between Different Circuit Courts of Appeals.**

The conflict must be between decisions on the same case. There is no allegation in the petition for a writ that the decision of the Circuit Court of Appeals for the Seventh Circuit is in conflict with a decision or decisions of other Circuit Courts of Appeals on the same subject matter or adjudicating the validity of the same patents.

The rule is stated in General Talking Pictures Corporation v. Western Electric Company, Inc., et al., 304 U. S. 175, at 178 and 179, 58 S. Ct. 849, at 851, as follows:

"Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals." (Citing cases.)

In Magnum Import Company v. Coty, 262 U. S. 159, Mr. Chief Justice Taft said (163), in speaking of the exercise of the jurisdiction to bring up cases by certiorari:

". . . The jurisdiction was not conferred upon this court merely to give the defeated party in the circuit court of appeals another hearing."

3. There Is No Question of General Interest.

This is a suit between private persons involving patent infringement. The question is primarily one of fact. Questions of patentable invention are one of fact. Thomson Spot Welder Company v. Ford Motor Company, 265 U. S. 445, 44 S. Ct. 533, 68 L. Ed. 1098.

Writs of certiorari are not granted to review questions of anticipation and invention where there is no conflict (as here) between decisions of the circuit courts of appeals. General Talking Pictures Corporation v. Western Electric Company, 304 U. S. 175, 546, at 178 and 179, 58 S. Ct. 849 at 851.

4. The Use of the Flexible Membrane Was Old in the Art.

Petitioner makes the point in his brief that the Court of Appeals has overlooked the fact that these method claims include the use of a flexible membrane upon the surface of the tool.

The District Court in his opinion (R. 239) pointed out that original Claim 5 which included "means for preventing the adhesion of plastic material placed in the casing

to the plunger," was rejected by the Patent Office on Laskey No. 1,466,509 (R. 318 and R. 61), France No. 1,288,554 (R. 306 and R. 61), and Kruck No. 482,369 (R. 286 and R. 61). Applicant acquiesced in this rejection by cancelling the claim (R. 158 and R. 61).

The petitioner cannot now again urge that such cancelled element is a part of his method. Schriber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211, 61 S. Ct. 235; I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, 443.

Hence, it is obvious that the Court of Appeals did not overlook such flexible membrane.

Further, the use of such a flexible membrane as pointed out in the action of the Patent Office of September 10, 1930 (R. 156-157, R. 61) is common practice and noninventive. The use of a waxed paper membrane was effectively ruled out of the claims as a new element and as being merely imitative by the Patent Office.

5. **The Method Claims Are Functional and Invalid.**

Stripped of all sophistry, these claims are merely directional of the use of the tool described in the patent.

The tool described in the patent (and in the rejected claims) consists merely of a casing wherein a plunger is slidably and controllably mounted therein for forcing plastic material therefrom onto a wall. The method claims, stripped of introductory clauses, recite the result or effect of using the tool, i. e., the quantity of plastic material so placed on the tool is pressed onto the wall to resemble stone.

The cases cited by petitioner in pages 14-18, inclusive, of his brief deal with processes that produce a new result or which may be performed by a machine as well as by hand. See quotation from Interstate Folding Box Co. v.

Empire Box Corporation, 68 F. (2d) 500, at 501 (C. C. A. 7, 1934), cited on page 14 of petitioner's brief, wherein he sets forth this sentence:

> " 'The act which is one of the successive steps of a valid process claim may be performed by a machine as well as by hand.' "

The inventor (petitioner herein) testified at the trial (R. 67 and 68):

> "I don't think that the process could be practiced by any other means without (the apparatus) unless it greatly resembled the description in these claims here. I would say (that the practicing of what was in the claims, as shown by the disclosure, is pretty well tied up with the apparatus described). No, (you could not practice this, what the patent teaches, by hand)." (Interpolations ours.)

All of the tools by which the method of the claims in suit could be practiced would have to be similar to the tool described in the patent. The inventor (petitioner) so stated at page 68 of the Record:

> "Q. Could you practice what your claims and disclosure teach by means other than the tool that you describe in it?
>
> A. A similar tool, yes.
>
> Q. But it would have to be similar; right?
>
> A. That is right."

The fact that petitioner has brought suit for infringement against these defendants alleging their practice of his method through similar tools is in itself a showing that he regards the tools as similar.

6. **The Corner Mold Patent Does Not Constitute Invention.**

Petitioner contends that since the applications (upon which these patents were granted) were copending, neither one could anticipate the other, and cites cases. However, each patent when issued must be for a *separate invention.* This is set forth by petitioner himself in quoting from Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co., 22 F. (2d) 259, at 260 (C. C. A. 2, 1927), at page 19 of his brief, wherein this appears at lines 4-7, inclusive, of the quotation from plaintiff's own brief:

> "The two applications were copending, and it is a matter of indifference which of the patents issued first, *provided that the claims are for separate inventions.*" (Our emphasis.)

The Court of Appeals held that there was no invention in the second patent and thus brings the rule squarely within the cases cited by petitioner.

Further, the court held that the second patent was nothing more than a solution of what any skilled workman, meeting this problem, having the old device before him, would have reached, without exercising any inventive genius.

The quotation taken by petitioner from defendant's brief, page 33, in the Court of Appeals, begs the question in that it includes the words "standing alone." But the second patent did not stand alone. It had to be inventive over the first patent, which it was not.

Thus it was pointed out in B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co., 122 F. (2d) 900 (C. C. A. 1, 1941), cert. den. 62 S. Ct. 917, 315 U. S. 823, 86 L. Ed. 219, and cited by petitioner in his brief at pages 19 and 20, that claims to be allowable in a second or later patent must be

for a separate invention. As to what constitutes invention is a factual thing and at times the judgment of the court will appear, and no doubt be, to a large extent personal and in that sense arbitrary, as was further pointed out in that case at page 909 thereof.

7. **The Decision of the Circuit Court of Appeals Was Correct.**

This case presented a definite and undisputed fact situation to the Court below. The claims of the earlier method patent were informative of how to use the tool. The use of the tool involved the movement of its parts which was described in the method claims. Such method claims are clearly invalid and functional of the use of the tool.

The claims of the corner mold patent do not constitute invention. They do not involve more than what one skilled in the art would do, in the light of the state of the art at that time. That does not arise to the dignity of invention.

Regardless of anything that could be resolved on this petition, respondents are still entitled to a dismissal hereof on the finding of the District Court, undisturbed in the Circuit Court, that petitioner (plaintiff) was in court with unclean hands, and not presented for review in this Court.

Respondents are entitled to the relief which the Court awarded.

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